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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/143,967	08/31/98	BERTMAN R	RP9-95-017V

EXAMINER	
HUYNH, B	
ART UNIT	**PAPER NUMBER**
2173	

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IBM CORPORATION
PSG IP LEGAL DEPT
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DATE MAILED: 12/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/143,967	Bertram et al.
Examiner	**Group Art Unit**
Huynh-Ba	2173

☒ Responsive to communication(s) filed on *Nov 1, 2000*

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *37-72* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *37-72* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

BA HUYNH
PRIMARY EXAMINER

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or © because:

The terminal disclaimer was not dated. A properly dated terminal disclaimer is required.

Claim Rejections - 35 USC § 103

2. Claims 37-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capps in view of Dipaolo et al. Rationales for the rejection continue to be as set forth in paragraph 5 of the 7/30/00 Office action.

REMARKS:

The 102(b) rejection: Applicant's arguments filed on 11/1/00 has overcome the 102(b) rejection based on US patent #5,5,390,281 (Luciw et al).

The 103(a) rejection: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dipaolo teaches the automatic filling when it is

determined that the entry will be a valid entry, e.g., in case of only one entry available, it is clear that the entry is the only valid one therefore will be filled-in automatically. In the context of Dipaolo's teaching, it is suggested that when an entry is determined as a valid entry it will be filled in automatically. Caps teach a predictive widget (predicting means) for displaying a history list 184 comprising an entry which is ranked as the most valid entry for a data field. Thus it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Dipaolo's teaching of automatic fill-in of the determined-valid-entry to Capps. Motivation of the combining is for automatically filling-in a data field with a determined most valid entry, thus saving the user from inputting the entry.

In response to applicant's arguments that Dipaolo's teaching of auto-fill directed to only one valid entry thus fails to meet the limitation "*one of predictive default and predictive fill*", the applicants appear to argue against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is further noted that Dipaolo's teaching of auto-fill meets the claimed language "*one of*" recited in the claim.

In response to the argument that the combined teachings does not teach the selecting of data entry from a predictive list based on a predetermined algorithm or recency of use, the applicants are referred to Capps' teaching of recency and frequency of use in figures 5-8.

In response to the argument that Capps' history list does not teach a leading portion with recency-of-use entries and trailing portion with frequency-of-use entries, the leading entry in list 184 is a recency-of-use entry and the trailing entry in the list is a least frequently used entry. It is noted that the list is ordered based on a combination of recency and frequency, however it would have been obvious to one of skill in the art, at the time the invention was made, to separate the list into recency-of-use portion and frequency-of-use portion. Making a given structure separable would have been obvious to one skill in the art (Nerwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. Of Int. 1969)).

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquires

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 308-6606 for informal or draft communications. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huynh-Ba whose telephone number is (703) 305-9794. The examiner can normally be reached on Monday-Friday from 8.00AM to 4.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Huynh-Ba
Primary Examiner
Art Unit 2173
1211/00

BA HUYNH
PRIMARY EXAMINER